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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,037	07/10/2001	Peter R. Bloeme	14081/255319	7782

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EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 08/19/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/902,037

Applicant(s)

BLOEME ET AL.

Examiner

Faye Francis

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 14.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the teaching that the contact is permitted between the gripping surfaces and all of the fingers of a thrower's hand, as now recited in claim 19. No new matter should be entered into the application.
2. The amendment filed 6/5/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: the gripping surfaces 18 are formed of irregular surfaces.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:  

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1 and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New matter.

The specification as originally filed does not provide support for the teaching of the first and second gripping surfaces formed of "irregular surfaces" as now recited in claim 1 and the contact is permitted between the gripping surfaces and all of the fingers of a thrower's hand, as now recited in claim 19. Accordingly these limitations are considered to be New Matter. Applicant is required to cancel the new matter in the response to this office action.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-9 and 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: the scope of the claim is unclear, since there are no criteria in the claim [or in the specification for that matter] for determining what the applicant considers to comprise "irregular surfaces" in line 6. It is not clear if the irregularity of the surfaces are because of their shapes, or because of their sizes or because they are spaced differently apart, or because of some other combination?

With respect to claim 2: the limitation "the first and second gripping surfaces are comprised of segmented raised surfaces" in the claim is inconsistent with the requirement in claim 1 of the first and second gripping surfaces being formed of irregular surfaces. How can irregular surfaces also be segmented?

With respect to claim 3: the limitation "the first and second gripping surfaces are comprised of staggered raised surfaces" in the claim is inconsistent with the

requirement in claim 1 of the first and second gripping surfaces being formed of irregular surfaces. How can irregular surfaces also be staggered?

With respect to claim 4: the limitation "the first and second gripping surfaces are comprised of uni-directional surfaces" in the claim is inconsistent with the requirement in claim 1 of the first and second gripping surfaces being formed of irregular surfaces. How can irregular surfaces also be uni-directional? Note also claim 6 in this regard.

With respect to claim 5: the limitation "the first and second gripping surfaces comprised of segmented, staggered, unidirectional surfaces" in the claim is inconsistent with the requirement in claim 1 of the first and second gripping surfaces being formed of irregular surfaces. How can irregular surfaces also be segmented, staggered and unidirectional?

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Sneddon.

Sneddon discloses in Fig 1 (also see attachment at the end of this Office Action wherein the letter A has been added by the examiner), a disc for being thrown in the air, comprising: an annular rim 22 formed along an outer periphery of the disc and having a diameter of less than 9 inches [6 inches], a flight plate A in a central portion of the disc, a transition area [grippable portion 35] joining the annular rim to the flight plate and

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presenting a sloped surface between the annular rim and the flight plate, the flight plate and the transition area having a thickness greater than 0.093 inches [underbelly thickness of one half inch and the exoskeletal thickness of three-sixteenths inch] and the ratio of a height of the flight plate to a diameter of the annular rim is less than 1 to 9.

Since the device disclosed in the reference includes all of the structural elements of the claims it is presumed to be inherently capable of all the claimed functions including the ability to be used with canines.

***Claim Rejections - 35 USC § 102 and 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6 and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Frisbee manual, hereinafter Frisbee in view of Richilano.

Frisbee discloses in the Fig labeled as Master Model on page 30, a disc for being thrown in the air, comprising: an annular rim [lip] formed along an outer periphery of the disc, a generally flat flight plate [cupola roof] formed in a central portion of the disc, a transition area joining the annular rim to the flight plate and presenting a sloped surface between the annular rim and the flight plate, a first and second gripping surfaces [lines of headrick] formed along the sloped surface of the transition area on a top and bottom sides of the disc as recited in claim 1. Additionally, Frisbee discloses the first and

second gripping surface have a texture as recited in claim 23 which forms a pattern of raised surfaces as recited in claim 24.

The requirement in claims 4-6 for uni-directional first and second gripping surfaces is met by the raised surfaces [lines of headrick] since they are all in one direction [outwardly or circumferentially].

Frisbee may not disclose the first and second gripping surfaces are comprised of irregular surface as recited in claim 1, the first and second gripping surfaces are comprised of segmented raised surfaces as recited in claim 2, the first and second gripping surfaces are comprised of staggered raised surfaces as recited in claim 3, the first and second gripping surface form surface discontinuities as recited in claim 22.

Richilano is cited to show desirability to have irregular, segmented and staggered raised gripping surfaces with surface discontinuities [col 3 lines 60-63]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the first and a second gripping surfaces in the device of Frisbee with irregular, segmented and staggered raised gripping surfaces as taught by Richilano in order to enhance the grip.

11. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frisbee in view of Richilano and further in view of Sneddon.

Modified device of Frisbee has most of the element in this claim as stated above, but may not have an annular rim having a thickness of 0.093 inches as recited in claim 7, the diameter of the annular rim is less than 9 inches as recited in claim 8 and the ratio of the height of the flight plate to the diameter of the annular rim of less than 1 to 9.

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Sneddon recognizes in the relevant art to provide a Frisbee with the missing features. It would have been obvious to further provide the disc of modified device of Frisbee with the missing elements for the purpose of making the devices easier to play with and to maintain stable and extended flight.

12. Claims 11, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sneddon in view of Frisbee.

Sneddon discloses most of the elements of these claims as stated in paragraph 8.

Sneddon does not disclose the uni-directional first and second gripping surfaces formed along the first and second portions of the transition area on a top and bottom sides of the disc.

Frisbee is cited to show desirability, in the same art of flying disc toys, to have a uni-directional first and second gripping surfaces formed along the first and second portions of the transition area. It would have been obvious to provide the disc of Sneddon with the first and second gripping surfaces [lines of headrick] formed along the first and second portions of the transition area on a top and bottom sides of the disc as taught by Frisbee to improve grip.

13. Claims 12-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sneddon in view of Frisbee as applied to claims 11, 14 and 16 and further in view of Richilano.

Modified device of Sneddon would have most of the element in these claims as stated above.



Modified device of Sneddon may not have the first and second gripping surfaces are which are comprised of segmented, staggered raised surfaces.

Richilano is cited to show desirability to have segmented and staggered raised gripping surfaces [col 3 lines 60-63]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the first and a second gripping surfaces in the device of Frisbee with segmented and staggered raised gripping surfaces as taught by Richilano in order to enhance the grip.

### ***Response to Arguments***

14. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adler and Mitchell disclose a flying disc having bumps 14 and spoilers 26 on the lower surface of the disc respectively. Ross, J. discloses a flying disc having peaks 14c on the upper surface of the disc.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

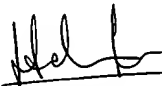
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

FF  
August 5, 2003

  
Kenneth B. Carlson  
Director

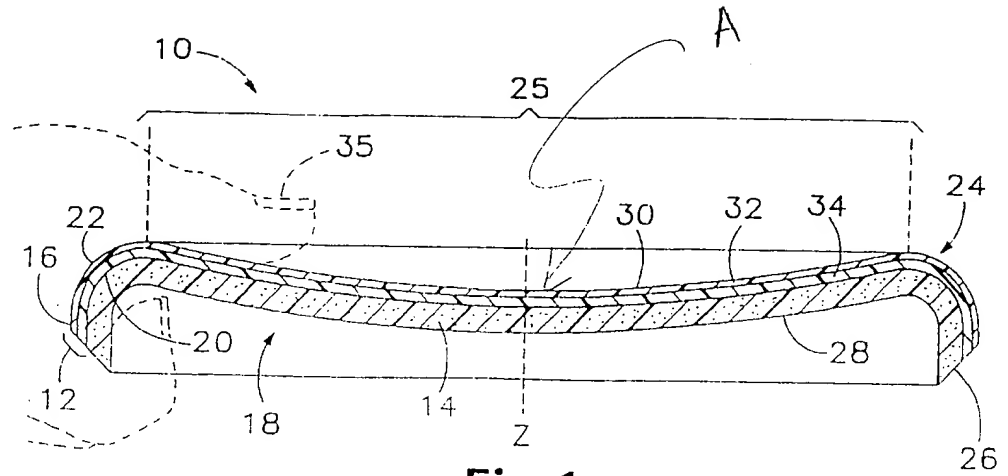


Fig. 1

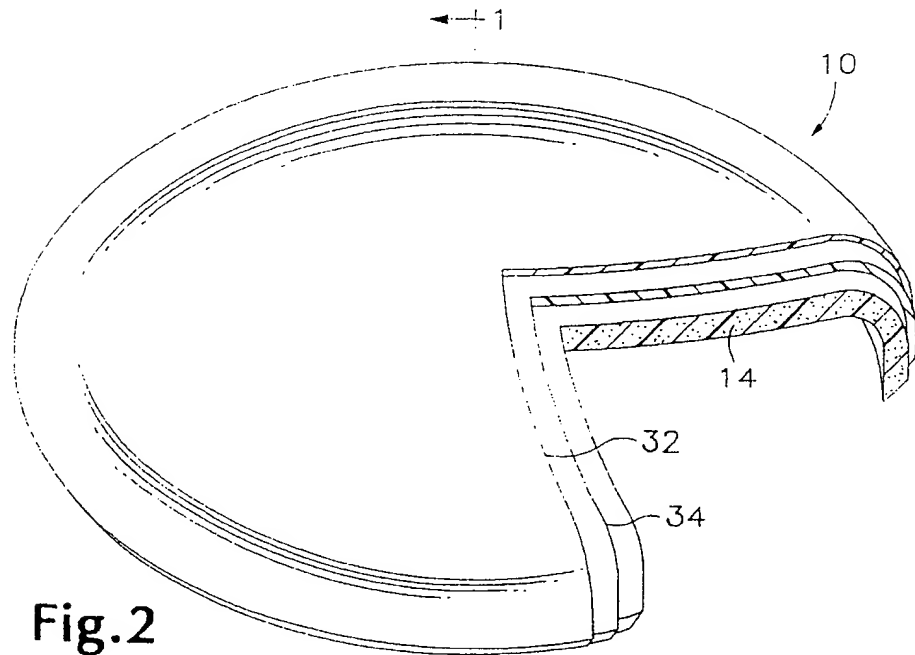


Fig. 2

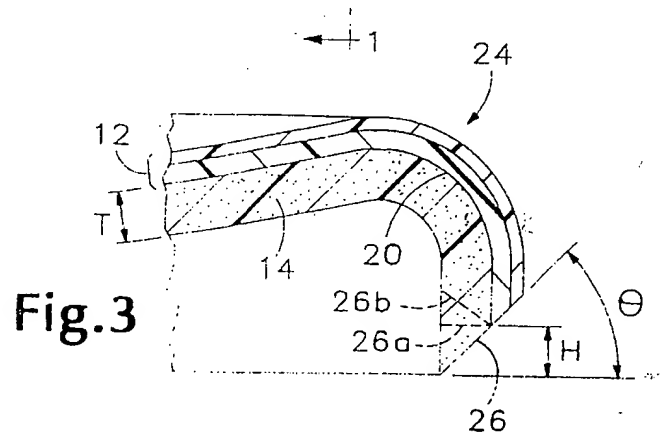


Fig. 3